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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,018	07/27/2000	Helmut Weber	70442.1201	9975
7590	03/29/2005		EXAMINER	
Peter A Sullivan Ronald Abramson Hughes Hubbard & Reed LLP One Battery Park Plaza New York, NY 10004			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	
			DATE MAILED: 03/29/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

4W

Office Action Summary	Application No.	Applicant(s)	
	09/627,018	WEBER ET AL.	
	Examiner	Art Unit	
	Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 February 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-7 is/are allowed.
- 6) Claim(s) 8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 February 2005 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

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Claim 8 is rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claim 8, lines 8-9, "disengagable with said...bottom shaft piece" and in lines 10-11, ""disengaged from said...bottom shaft piece" has no basis in the original disclosure. Even when the top shaft cutting piece 201 is in the position shown in figure 3, it is still attached to the bottom shaft piece 202 by attachment means such as link 223 (page 10, line 4-7 of the specification) and is therefore not disengaged from it.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Note the explanation in the paragraph above.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 is confusing and inaccurate for the reasons set forth above. Therefore the scope of this claim is

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unclear. Further, the tip portion is part of the bottom shaft piece as indicated in claim 8, lines 3-4. Therefore "tip portion and said bottom shaft piece" in claim 8, lines 9 and 10-11 makes no sense.

Claim 8 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Applicant's disclosure. The instrument shown in figures 1A-1D of the application is admitted as being prior art. This admitted prior art instrument is a convertible rongeur comprising front handle piece 106, bottom shaft piece 102 having tip portion (member 105 in combination with the distal portion of shaft piece 102 which is directly below gap 110) and handle portion 118, and a longitudinal axis from said handle portion to said tip portion, top shaft cutting piece 101 slideably engaged along said longitudinal axis with the tip portion (i.e., when the top shaft cutting piece 101 slides forwardly from the position shown in figure 1A so that it slides along the distal portion of shaft piece 102 which was directly below gap 110 but is now being covered by cutting piece 101), the top shaft cutting piece 101 being disengageable with the tip portion (when the top shaft cutting piece 101 is retracted to the position shown in figure 1A so that it no longer is directly above and engaged to the distal portion of shaft piece 102) wherein, when the top shaft

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cutting piece is disengaged from the tip portion, the top shaft cutting piece remains attached to the rongeur so as to retain all parts of the rongeur in one attached unit. The phrase "disengagable with said...bottom shaft piece" in lines 8-9 and ""disengaged from said...bottom shaft piece" in lines 10-11 is both new matter and inaccurate for the reasons set forth above.

Alternatively, it would have been obvious that the top shaft cutting piece 101 is disengageable with the tip portion since cutting piece 101 can be retracted to the position shown in figure 1A in which it is not above and does not contact the tip portion.

Claims 1-7 are allowed.

Applicant's arguments filed Feb. 24, 2005 have been fully considered but they are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
3/24/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731